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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/128,462	08/04/98	OBARA	S ISHP.020

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EXAMINER

LUBY, M

ART UNIT

PAPER NUMBER

3721

4

DATE MAILED:

11/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/128,462

Applicant(s)

Sho Obara et al.

Examiner

Matthew Luby

Group Art Unit

3721



☒ Responsive to communication(s) filed on Oct 18, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) 5, 6, and 8-12 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 and 7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group III, claims 1-4 and 7 in Paper No. 3 is acknowledged. The traversal is on the ground(s) that the subject matter of claims 1-12 is sufficiently related that a thorough and complete search for the subject matter of the elected claims would necessarily encompass a thorough search for the subject matter of the non-elected claims. This is not found persuasive because of the reasons provided for in Paper No. 2 and because Species I-V are still found patentably distinct. .

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 5, 6 and 8-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected Species, the requirement having been traversed in Paper No. 3.

Priority

3. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Japan on 1/23/96. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

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4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 1/23/96. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-4 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ The phrase "having an outer circumferential surface opposite to the feed course" (claim 1, lines 5-6) is vague and indefinite because it is unclear how a "surface" can be "opposite to the feed course".

✓ The phrase "for processing package material being by rotating the processing roller" (claim 1, lines 7-9) is vague and indefinite because it is not a complete recitation, especially regarding the words "being by rotating".

✓ The phrase "a value set through the setting device" (claim 1, lines 18-19 and 22-23) is vague and indefinite because it is unclear whether this "value" is the same or different from the "value" set previously in claim 1, line 12.

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✓ The phrase “at the pitch corresponding to a value set” is vague and indefinite because it is unclear what this pitch is. For example, is this the same “pitch” of claim 1, line 13?

✓ The phrase “a certain positional relationship” (claim 2, lines 5-6) is vague and indefinite because it is unclear what applicant intends to claim by reciting “a certain....relationship”. The word “certain” renders this phrase vague and indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson et al. (5,447,486) hereafter ‘486.

‘486 discloses applicant’s claimed package material processing machine including a feeding device (12), a processing roller (26) with at least one projection (102) on an outer circumferential surface (see Fig. 3), a setting device (this is inherent since there are registration marks on the web of material, there must be a device for making these marks; see col. 6, lines 64-66), a feed amount detection device (col. 7, lines 62-64), a rotation control device (col. 8, lines 20-30), a mark detection device (140) detecting registration marks (col. 6, line 64) and a speed

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control device (col. 8, lines 20-30) to set the relative speed between the processing roller and package material at 0 (col. 8, lines 25-30).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 7, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over '486.

'486 discloses all of applicant's claimed apparatus including plural projections (102; see Fig. 3) on the processing roller surface with spaces therebetween and would appear to disclose a cutting edge on each projection, but assuming *arguendo* that '486 does not teach a cutting edge on each projection, Official Notice is taken that it is notoriously well known in the art to provide a cutting and sealing mechanism mounted upon the same roller (since processing roller 26 is a seal roller) for cutting of a web after it has been sealed to make a bag (see abstract). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to provide a cutting edge on each sealing projection of the '486 processing roller in order to cut the package material after it is sealed.

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Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The included patents are cited to show similar methods of producing gored bags.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Luby whose telephone number is (703) 305-0441. The examiner can normally be reached weekdays from 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo, can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

m.l.

November 3, 1999

A handwritten signature in black ink, appearing to be 'Peter Vo', written over a horizontal line.

**PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**